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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,134	08/25/2003	Young-min Cheong	1293.1825CIP	1038

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WASHINGTON, DC 20005

EXAMINER
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KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/647,134

Applicant(s)

CHEONG ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15, 18 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-8 is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/622,785.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continuation***

U.S. Patent Application Serial Number 10/647,134, filed on August 25, 2003, is a Continuation-In-Part of U.S. Patent Application Serial Number 10/622,785, filed on July 21, 2003, now abandoned.

Claims 1 and 3-20 are currently pending.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/622,785, filed on July 21, 2003.

### ***Drawings***

The drawing changes received on August 15, 2006, have been approved.

### ***Information Disclosure Statement***

The information disclosure statement filed August 18, 2006 (Item AM) "Office Action issued in Japanese Patent Application No. 2003-298735 on May 23, 2006" fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The

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aforementioned reference AM is completely in Japanese. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 9 (line 8) and also claim 20 (line 6), the phrase “a coil assembly including ***mutually non-coplanar*** at least one focus coil, at least one tracking coil, and a tilt coil ...” is vague and ambiguous. More concretely, it is unclear as to what the scope of the phrase “***mutually non-coplanar*** at least one focus coil, at least one tracking coil, and a tilt coil” Does it mean that the at least the focus coil and the tracking coil are mutually non-coplanar?; does it mean that all three coils, that is, the focus coil, the tracking coil and the tilting coil are mutually non-coplanar? The scope of the claims cannot be readily ascertained.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9, 10, 14, 15 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawano (US 2003/0012090 A1).

Insofar as the claims can be understood, as per claims 9 and 20, Kawano (US 2003/0012090 A1) discloses an objective lens driving apparatus (e.g., FIG. 1) used with an optical pickup, comprising: a holder (8, 9); a blade (1) on which an objective lens (2) is mounted and which is supported to elastically move with respect to the holder (8, 9); a pair of magnetic members (5, 5) positioned through a center of the blade (1) to face each other; and a coil assembly including “mutually non-coplanar” at least one focus coil (3f), at least one tracking coil (3tr), and a tilt coil (3ti) being entirely disposed between the magnetic members (see FIG. 1), wherein laminated coil unit (3) mounted in notch (1a) is disposed in magnetic gap (5g). That is, the coils have coil axes which do not lie in the same plane; the axis being defined as the center of the coil winding. The four coil axes of tracking coils (3tr), the single coil axis of the focus coil (3f) located on circuit board (31), are non-coplanar; additionally, the coil axes of the two tilting coil (3ti) are non-coplanar with any of the aforementioned axes of the tracking or focusing coils, as seen in Fig. 1.

As per claim 10, wherein each of the pair of magnetic members (5) is polarized into two poles (see FIG. 2).

As per claim 14, wherein the at least one focus coil (3f) is disposed on one of an upper or a lower side of the tilt coil (3ti) (i.e., board (31) being over board (32)), and the at least one

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tracking coil (3tr) comprises first and second tracking coils respectively attached on both sides thereof (i.e., on board (31)).

As per claim 15, wherein the same poles of the magnets (5) face each other (albeit, not in the same plane) - see FIG. 2.

Additionally, as per claim 20, Kawano (US 2003/0012090 A1) discloses an objective lens driving apparatus (FIG. 1) used with a pickup assembly, comprising: a holder (8, 9); a movable blade (1); a pair of magnets (5, 5) positioned through a center of the blade (1); and a coil assembly (3) including at least one focus coil (3f), at least one tracking coil (3tr) and a tilt coil (3ti) positioned entirely between the pair of magnets (5, 5).

### ***Response to Arguments***

Applicant's arguments filed August 15, 2006 have been fully considered but they are not persuasive.

The Applicant alleges:

Regarding claims 9 and 20, Kawano fails to disclose or suggest an objective lens driving apparatus used with an optical pickup, comprising a coil assembly including mutually non-coplanar at least one focus coil, at least one tracking coil, and a tilt coil being entirely disposed between the magnetic members, as recited in claim 9, or an objective lens driving apparatus used with a pickup assembly, comprising a coil assembly including mutually non-coplanar at least one focus coil, at least one tracking coil and a tilt coil positioned entirely between the pair of magnets, as recited in claim 20.

Rather than being mutually non-coplanar, Kawano discloses a focus coil 3f and tracking coils 3tr formed coplanar on a printed circuit board 31 (see for example, Figs. 1 and 9 of Kawano). In various other figures, such as Figs. 8,

20, 21, 23, 24, 27 and 31, Kawano discloses various coplanar arrangements of the relevant coils.

See page 10-11 of the Response filed on August 15, 2006.

The Examiner, as set forth in the rejection, supra, that the amended claim 9 and 20 are ambiguous in their scope. That is, with regard to claim 9 (line 8) and also claim 20 (line 6), the phrase “a coil assembly including *mutually non-coplanar* at least one focus coil, at least one tracking coil, and a tilt coil ...” is vague and ambiguous. More concretely, it is unclear as to what the scope of the phrase “*mutually non-coplanar* at least one focus coil, at least one tracking coil, and a tilt coil.” Does it mean that the at least the focus coil and the tracking coil are mutually non-coplanar?; does it mean that all three coils, that is, the focus coil, the tracking coil and the tilting coil are mutually non-coplanar? The scope of the claims cannot be readily ascertained.

Insofar as the claims can be understood, the Examiner maintains that Kawano (US 2003/0012090 A1) discloses a coil assembly including “mutually non-coplanar” at least one focus coil (3f), at least one tracking coil (3tr), and a tilt coil (3ti) being entirely disposed between the magnetic members (see FIG. 1), wherein laminated coil unit (3) mounted in notch (1a) is disposed in magnetic gap (5g). That is, the coils have coil axes that do not lie in the same plane; the axis being defined as the center of the coil winding. The four coil axes of tracking coils (3tr), the single coil axis of the focus coil (3f) located on circuit board (31), are non-coplanar; additionally, the coil axes of the two tilting coil (3ti) are non-coplanar with any of the aforementioned axes of the tracking or focusing coils, as seen in Fig. 1.

Nothing in the claims requires that the entire winding extent of each coil lie in a mutually differing plane, as Applicant *appears* to argue in his response.

Pertaining to the claims rejected under 35 U.S.C. § 102 as being anticipated by the disclosure of Kawano (US 2003/0012090 A1) the following should be noted. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); *cert. dismissed*, 468 U.S. 1228 (1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 72.1 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The Examiner, as clearly articulated in the rejection, *supra*, has set forth a one-to-one correspondence with each and every element of the *claimed* invention. More concretely, as recited MPEP§2106:

Office personnel are to give claims their ***broadest reasonable interpretation*** in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). ***Limitations appearing in the specification but not recited in the claim are not read into the claim.*** *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). [Emphasis in bold italics added].



Moreover, one must also bear in mind that limitations contained within Applicant's arguments cannot be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 386 F.2d 924, 155 USPQ 687 (CCPA 1968).

As set forth in the MPEP § 706, "the standard to be applied in all cases is the "preponderance of the evidence" test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable." Clearly, the Examiner has established that one of ordinary skill in the art would *reasonably* construe the one-to-one correspondence with each and every element of the *claimed* invention, in the manner set forth in the rejection, *supra*, by at least the *preponderance* of the evidence. The Applicant's arguments have fallen well short of rebutting the Examiner's *prima facie* case of anticipation.

#### ***Allowable Subject Matter***

Claims 1 and 3-8 are presently allowed.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

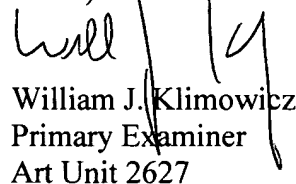
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
William J. Klimowicz  
Primary Examiner  
Art Unit 2627

WJK